

### **REMARKS**

Claims 1-20 are pending.

In the office action mailed February 5, 2007, the claims were objected to because the Examiner considered various claim limitations to have been recited “passively or optionally.” On page 2 of the office action, the Examiner said that the claims should be amended to remove limitations that could be interpreted as being optional.

Claims 1-20 were also rejected under 35 U.S.C. §101 because claims 1 and 15 allegedly failed to claim a “useful, concrete, and tangible result.” Claims 2-14 and 16-20 appear to have been rejected under §101 because they inherently contain all of the limitations of claims 1 and 15 respectively.

Claims 1-20 were rejected under 35 U.S.C. §112 ¶2 as being indefinite. The Examiner ostensibly described how claims 1-14 fail under 35 U.S.C. §112 ¶2, however, the Examiner did not specify how any of claims 15 and 17-20 are indefinite. It thus appears that claims 15 and 17-20 were not rejected under 35 U.S.C. §112 ¶2 but were inadvertently grouped together with claims 1-4 because there is no explanation as to why or how claims 15 and 17-20 are indefinite.

The Examiner rejected claims 1-14 under 35 U.S.C. §112 ¶2 because they did not recite any structure, such as a processor or memory. The Examiner thus considered claims 1-14 as not really being directed to structure but instead directed to a process and therefore indefinite.

Claims 1, 4, 5, 8, 13 and 14 were also characterized as using terms that are passive or optional. Claims 2, 3, 6, 7 and 9-12 were rejected because of their dependence on claims 1, 4 and 5.

Claim 6 and 16 were rejected because a claim term ostensibly lacked antecedent basis. Claims 7 and 8 were rejected because of the claim 6 rejection.

Lastly, claims 1-20 were rejected under 35 U.S.C. §102(e) as being anticipated by pre-grant publication 2002/0029214 to Yianilos et al. The Examiner ostensibly identified where the limitations of claims 1-20 can be found in *Yianilos* on pages 5-10 of the office action.

Claims 1-20 have been amended in response to the objections and various rejections and are believed to be in condition for allowance.

The Examiner's objections to claims 1-20 are believed overcome by claim language revisions that remove passivity and/or uncertainty as to whether various steps are performed. By way of example, one term that was objected to was "selectably," which has been deleted from most claims but retained in a few claims where the term is required to indicate that alternative steps can be performed. Additional revisions were made to the claims in order to make the claims more easily understood.

The phrase, "at least one" has been replaced with the indefinite article "a" in order to shorten the claims' length and to improve their readability. The indefinite article "a" is well known to be properly used as a function word and placed before singular nouns as referents, the numbers of which are unspecified. By revising the claims to use an indefinite article instead of the phrase, "at least one" the claims are easier to read but their scope is not changed.

Under English grammar rules, and as defined by the Merriam-Webster Collegiate Dictionary and under well-established Federal Circuit authority, the indefinite article "a" that is used in the amended claims refers to a noun, the number of which can be one or more than one. In other words, substituting the indefinite article "a" for "at least one" does not change the claims' scope.

The appellation "first," which was used in the claims to identify databases, has been deleted to further simplify the claims. Deleting "first" as an appellation for a database should not be construed as limiting the claimed method to apply to only one database. Indeed, the specification makes it clear the mobile node and the network part can each have multiple databases stored in each of them and that hash values can be formed from the contents of any of them. Thus, deleting "first" should not be construed as narrowing the claim.

The applicant believes that removing terms which the Examiner considered to be passive and revising claim language to make it clearer is not a claim narrowing amendment that gives rise to a *Festo*-like estoppel because such revisions do not surrender subject matter. Revising the claims to remove passivity and to simplify language does not narrow the claims to avoid prior art; it merely clarifies what was already recited in the claims when they were filed. If the Examiner contends that such revisions constitute a claim-scope surrender under *Festo*, the

applicant asks that the Examiner set forth in detail, all of the reasons why such amendments narrow the claims' scope.

The rejections that were made under 35 U.S.C. §101 are traversed by amendments to claims 1 and 15 that make the claims recite specific useful, concrete and tangible results. Paraphrased, amended claims 1 and 15 recite that the contents of a network copy of a database and a mobile copy of a database can be determined to be synchronized with each other (or not synchronized) by comparing database group hash values that were separately computed at the mobile node and at the network. The claim rejections made under 35 U.S.C. §101 are thus traversed.

The rejections made under 35 U.S.C. §112 are traversed by amending claims 1-14 such that they are no longer directed to an apparatus. Claims 1-14 are now directed to a method performed by, or at, *the mobile node*. Claim language the Examiner considered passive or optional has been deleted and replaced by unambiguous terms.

Various terms were used in the claims that were similar, but for which there was no strict antecedent basis between claims. Such terms have been revised to provide strict antecedent basis for each term.

The applicant contends that amending the claims to overcome the rejection made under 35 U.S.C. §112 is not a narrowing amendment that gives rise to a *Festo*-like estoppel because such revisions were not made to avoid prior art. The amendments to overcome the rejection under §112 merely clarify claims, which the Examiner considered to be unclear, i.e., indefinite. If the Examiner contends that amending claims 1-14 to recite a method instead of an apparatus narrows the claims in any way, the applicant asks the Examiner to set forth in detail, all of the reasons why such amendments narrow the claims' scope to avoid prior art.

The rejections made under 35 U.S.C. §102(e) are also traversed by the amendments to claims 1 and 15.

Amended claims 1 and 15 are directed to methods for determining whether a database in a mobile device (e.g., a cell phone, Blackberry® laptop or PDA) is identical to a corresponding copy of the database that is kept in the network through which the mobile device communicates. Paraphrased, the claims require the mobile node to compute a hash value, (i.e., the group hash

value) from other hash values (i.e., the individual record hash values) that are formed from database records. In other words, the amended claims require group hash value, which is a hash of a hash. The group hash value computed at the mobile node is sent to the network where it is compared to a group hash value computed by the network. If the group hash value computed by the mobile node matches the group hash value computed by the network the databases from which the hashes were computed are considered to be identical.

Support for the amendments to claims 1 and 15 can be found in the specification. No new matter has been added.

Paragraph 0043 states that individual hash generator 58 forms individual hash values, which represent individual data records. Paragraph 0043 also states that the individual hash values are provided to the group hash generator 66. Paragraph 0044 also states that the group hash generator forms group hash values using “values of the individual hashes generated by the individual hash generator.” The group hash value recited in amended claims 1 and 15 is thus a hash of one or more hash values.

Paragraph 0049 states that individual hashes are formed and then buffered at the buffer 64. The paragraph states that a group hash associated with a group of data records is formed by the group hash generator. The group identifier identifies the group (of data records) with which the group hash value is associated. Thus, paragraph 0049 also states that the group hash generator generates the group hash value, from one or more the individual record hash values, i.e., a hash of a hash.

Paragraph 0049 states that when a group hash value is sent from the mobile node to the network part, the network part compares its copy of the group hash value to the group hash value received from the mobile node. If the two hash values match, the database copies are considered identical. If the two hash values do not match, paragraph 0049 states that the network part requests the mobile node to send data records of the group for which the group hash values did not match. Mobile-node individual record hash values are compared to network hash values of the same records to identify which records are different.

As set forth above, claims 1-20 were rejected under 35 U.S.C. §102(e) as being anticipated by *Yianilos*. *Yianilos* admittedly teaches a method of determining whether two copies of the same database are matched by comparing hash values computed from each copy, however, *Yianilos* does not teach the formation of a hash value from other hash values. In other words, *Yianilos* does not teach what is recited in amended claims 1 and 15. Amended claims 1 and 15 (and the claims that depend from them) thus avoid *Yianilos* and traverse their rejection under 35 U.S.C. §102.

The applicant contends that amended claims 1-20 overcome the Examiner's objections and traverse the Examiner's rejections. The claims are therefore believed to be in condition for allowance. The applicant asks that the claims be reconsidered and allowed to issue.

Respectfully submitted,

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